REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 12-25 are pending. Claims 12, 16, 18, 21, and 23 have been amended. No new matter has been added.

The outstanding Office Action rejects Claims 12-25 under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1, 2, 3, 8-11, and 14-16 of U.S. Patent No. 6,298,196; rejects Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as anticipated by Kori, et al. (U.S. Patent No. 5,778,064, herein "Kori"); rejects Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Tamada, et al. (U.S. Patent No. 5,729,717, herein "Tamada"); rejects Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Cloutier, et al. (U.S. Patent No. 5,847,771, herein "Cloutier").

Rejection of Claims 12-25 under the Doctrine of Obviousness-Type Double Patenting

In response to the obviousness-type double patenting rejection, Applicants agree to file a terminal disclaimer once these same claims are indicated as being allowable over the asserted prior art. A terminal disclaimer is possible since the present application and U.S. Patent No. 6,298,196 are assigned to the same entity. Accordingly, Applicants respectfully request that the rejection of Claims 12-25 under the doctrine of obviousness-type double patenting be held in abeyance until the claims are indicated as being allowable over the asserted prior art.

Rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e)

In regard to the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) as anticipated by Kori, Applicants respectfully traverse the rejection for the following reasons.

To establish anticipation of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e), the

outstanding Office Action must show that each and every feature recited in Claims 12, 14-16, and 21 is either explicitly disclosed or necessarily present in Kori.[1]

The outstanding Office Action asserts that Kori discloses all of the features recited in Claims 12, 14-16, and 21. Applicants respectfully disagree.

Claim 12 recites a method of screening a digital recording apparatus to determine whether a digital signal may be received by the digital recording apparatus comprising, *inter alia*, steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

Kori does not disclose at least the above-mentioned subject matter of Claim 12. The outstanding Office Action cites Fig. 6 and col. 5, line 15 to col. 6, line 9; however, the above-mentioned subject matter of Claim 12 is not disclosed here. In Kori, "VTR 2 is comprised of a head mechanism 13, an auxiliary data processing circuit 15, a VBI signal decoder 16 and a recording signal processing circuit (not shown in FIG. 6)."[2] "VBI decoder 16 extracts the VBI signal from the analog HD signal, extracts the CGMS information therefrom and supplies the CGMS information to auxiliary data processing circuit 15."[3] "Auxiliary data processing circuit 15 supplies to the recording signal processing circuit an indication of whether the HD signal is recordable (i.e., the original CGMS data is either 00 or 10), or whether the HD signal is not recordable (i.e., the original CGMS data is 11)."[4] In other words, in Kori, a recording apparatus (i.e., VTR2) always performs processing in compliance with copyright protection information (i.e., the CGMS data) before starting to record. Nowhere does Kori disclose the steps of detecting whether the digital recording apparatus

[1] See MPEP § 2131.
[2] Col. 5, lines 40-42 of Kori.
[3] Col. 5, lines 45-48 of Kori.

performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 12.

Accordingly, Applicants submit that Claim 12 is patentable and the rejection of Claim 12 under 35 U.S.C. § 102(e) should be withdrawn. Independent Claims 16 and 21, although of different scope and/or statutory class, include features similar to those in Claim 12 discussed above. Claims 13 and 14 depend from Claim 12. Thus, Applicants respectfully request that the rejection of Claims 12, 14-16, and 21 under 35 U.S.C. § 102(e) be withdrawn as well.

Rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a)

In regard to the rejection of Claims 18-20 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Tamada, Applicants respectfully traverse the rejection for the following reasons.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be demonstrated. First, Kori in view of Tamada, when combined, must teach or suggest each and every element recited in the claims.[5] Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention.[6] Third, a reasonable probability of success must exist with respect to the proposed combination relied upon in the rejection.[7]

Claim 18 recites a control IC for controlling a link layer of a digital interface comprising, *inter alia*, means for allowing a digital signal to be received by a digital

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[4] Col. 6, line 67-col. 6, line 4 of Kori.
[5] See MPEP § 2143.
[6] See id.

recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information.

As discussed above with respect to Claim 12, Kori does not teach or suggest allowing a digital signal to be received by a digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 18, as amended. Tamada does not cure the deficiencies of Kori. For example, even assuming Tamada could properly be combined with Kori, which Applicants dispute, Tamada does not teach or suggest at least allowing a digital signal to be received by a digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 18, as amended.

Accordingly, Applicants submit that Claim 18 is patentable and the rejection of Claim 18 under 35 U.S.C. § 103(a) should be withdrawn. Independent Claim 23, although of different scope and/or statutory class, includes features similar to those in Claim 18 discussed above. Claims 19, 20, 24, and 25 depend from Claims 18 or 23. Thus, Applicants respectfully request that the rejection of Claims 19, 20 and 23-25 under 35 U.S.C. § 103(a) be withdrawn as well.

Rejection of Claims 13, 17, and 22 under 35 U.S.C. § 103(a)

The outstanding Office Action rejects Claims 13, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Kori in view of Cloutier. Applicants respectfully traverse the rejection.

Claims 13, 17, and 22 depend on Claims 12, 16, or 21. As discussed above with respect to Claims 12, 16, or 21, Kori does not teach or suggest each and every element recited in Claims 12, 16, or 21. For example, Kori does not teach or suggest at least the steps of detecting whether the digital recording apparatus performs processing in compliance with

[7] See id.

copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 12 and as similarly recited in Claims 16 and 21.

Cloutier does not cure the deficiencies of Kori. For example, even assuming Cloutier could properly be combined with Kori, which Applicants dispute, Cloutier does not teach or suggest at least steps of detecting whether the digital recording apparatus performs processing in compliance with copyright protection information and allowing a digital signal to be received by the digital recording apparatus in response to detection that the digital recording apparatus performs processing in compliance with the copyright protection information, as recited in Claim 12 and as similarly recited in Claims 16 and 21.

Accordingly, Applicants submit that Kori in view of Cloutier does not render Claims 12, 16, and 21 obvious under 35 U.S.C. § 103(a). Since Claims 15, 17, and 22 depend on Claims 12, 16, and 21, Applicants respectfully request that the rejection of Claims 15, 17, and 22 under 35 U.S.C. § 103(a) be withdrawn and Claims 15, 17, and 22 be allowed.

Conclusion

Accordingly, in view of the foregoing amendments and remarks, it is respectfully submitted that the present application, including Claims 12-25, is patentably distinguished over the prior art. If the Examiner agrees, the Examiner is invited to contact the undersigned, so that the undersigned can file a terminal disclaimer to formally put the application in condition for allowance.

Respectfully submitted,

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